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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY FLICKINGER

Appeal 2009-000,850
Application 09/749,255¹
Technology Center 2600

Decided:² June 10, 2009

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and MARC S.
HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Prime Research Alliance E., Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 2-5, 10-12, and 28-42.³ We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellant's invention relates to a method and system whereby television advertisements can be delivered in conjunction with and correlated with advertisements that are presented to viewers in an Interactive Program Guide (IPG) or Electronic Program Guide (EPG). Programming ads and IPG ads are temporally linked and scheduled to be presented to the appropriate target group in a variety of sequences that may enhance the effectiveness of an advertising campaign (Spec. 5-6).

Claim 28 is exemplary:

28. A method of enhancing the effectiveness of IPG ads and programming ads in a television network environment, the method comprising:

(a) storing an IPG ad queue, the IPG ad queue containing an ordered list of IPG ads;

(b) storing a programming ad queue, the programming ad queue containing an ordered list of programming ads to be inserted in a programming avail;

(c) linking at least one IPG ad with at least one programming ad to form at least one IPG-programming ad combination;

(d) displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad in the programming avail, wherein the IPG ads are displayed in accordance with the IPG ad queue; and

(e) reordering the IPG ad queue in accordance with the displayed programming ad.

³ Claims 1, 6-9, and 13-27 have been cancelled.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Esch	US 5,283,639	Feb. 01, 1994
Hite	US 6,002,393	Dec. 14, 1999
Alexander	US 6,177,931 B1	Jan. 23, 2001
Boylan, III	US 6,799,326 B2	Sep. 28, 2004
Hendricks	US 6,738,978 B2	May 18, 2004

Claims 10, 12, 28-33, 38, and 40-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Hite.

Claims 2, 3, 5, 34, 35, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Hite and Hendricks.

Claims 4 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Hite, Hendricks, and Esch.

Claims 11 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Hite and Boylan.

Throughout this decision, we make reference to the Appeal Brief (“Br.,” filed October 23, 2007), the Reply Brief (“Reply Br.,” filed April 4, 2008) and the Examiner’s Answer (“Ans.,” mailed February 5, 2008) for their respective details.

ISSUES

Appellant argues that the Examiner has failed to establish a prima facie case of obviousness, because none of the applied references teaches storing an IPG (interactive program guide) ad queue containing an ordered list of IPG ads, nor reordering the IPG ad queue in accordance with the displayed programming ad (claim 28) or in accordance with the reordering

of the programming ad queue (claim 31) (App. Br. 13). The Examiner finds that Alexander teaches the claimed “ordered list” because the ads of Alexander, being stored in RAM, are inherently in “some” order, even a random one (Ans. 13), and further finds that Alexander teaches reordering the IPG ad queue (Ans. 14).

Appellant’s arguments present us with the following issues:

1. Has Appellant shown that the Examiner erred in finding that Alexander teaches storing an IPG ad queue containing an ordered list of IPG ads?
2. Has Appellant shown that the Examiner erred in finding that Alexander teaches reordering the IPG ad queue in accordance with the displayed programming ad (claim 28) or the reordering of the programming ad queue (claim 31)?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellant, the invention concerns a method and system whereby television advertisements can be delivered in conjunction with and correlated with advertisements that are presented to viewers in an Interactive Program Guide (IPG) or Electronic Program Guide (EPG). Programming ads and IPG ads are temporally linked and scheduled to be presented to the appropriate target group in a variety of sequences that may enhance the effectiveness of an advertising campaign (Spec. 5-6).

2. Ads to be displayed next in the IPG can be ordered and prioritized according to a number of parameters, e.g., establishing a priority linkage between programming and IPG ads (Spec. 13).

Alexander

3. Alexander teaches an Electronic Program Guide (EPG) that includes a picture-in-picture (PIP) window and two Panel Ad Windows, as well as program guide information (col. 3, ll. 6-9).

4. Alexander teaches that “[a]ds can rotate. For example, different ads can appear each time the user enters the same page/section of the Guide. There is no hard limit on the number of ads placed in rotation. Ads can be assigned a priority with the ad of the highest priority being displayed the first time a hard page or section is accessed. Then the second priority ad is displayed the next time the user views this page and so forth” (col. 26, ll. 45-51).

Hite

5. Hite teaches targeting TV advertisements to individual customers. A command signal is sent to the display site commanding the display of a selected advertisement selected for the individual consumer (Abstract).

Hendricks

6. Hendricks teaches a network controller for a television delivery system that provides all cable network monitoring and control of set top terminals within the cable headend (col. 3, ll. 51-53).

Esch

7. Esch teaches a communications distribution system which allows customizing the video presentation at each ground terminal (col. 1, ll. 13-16).

Boylan

8. Boylan teaches a system in which local advertisements are provided to interactive television program guides that are implemented on the user television equipment associated with a television distribution facility (col. 1, l. 66 – col. 2, l. 2).

PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

ANALYSIS

CLAIMS 10, 12, 28-33, 38, AND 40-42

Both pending independent claims (claims 28 and 31) recite storing an IPG (interactive program guide) ad queue, the IPG ad queue containing an

ordered list of IPG ads, and reordering the IPG ad queue under specified conditions.⁴

The Examiner finds that Alexander stores IPG ads in an ordered list (Ans. 4). Responding to Appellant's arguments, the Examiner admits that Alexander is silent as to what type of order the ads are stored in (Ans. 5). The Examiner reasons that because Alexander does teach that the ads are stored in RAM, "Alexander inherently teaches that ads are stored in a particular type of order (e.g. random, consecutive or by genre) by simply teaching that the ads or (*sic*, are) stored in RAM" (Ans. 13). With respect to the recitation of reordering the IPG ad queue, the Examiner finds that Alexander "explicitly teaches reordering of IPG ad storage," based on assigned priority (Ans. 14).

We disagree with the Examiner's position. While we agree with the Examiner that Alexander does not disclose any type of order for storage of the ads disclosed therein, it is incorrect to state that a "random" order corresponds to the "ordered list" claimed. Were it possible to interpret a random order as a species of "order" such that it could read on an ordered list, the effect would be to read the word "random" completely out of the claim. Appellant's thesaurus citation (Reply Br. 3), indicating that "random" is an antonym of "ordered," is further evidence that "random" cannot accurately be described as a species or kind of "order." As Appellant further notes (Reply Br. 3), the Specification discloses that "ads to be displayed next in the IPG can be ordered and prioritized according to a number of

⁴ In claim 28, the IPG ad queue is reordered in accordance with the displayed programming ad; in claim 31, the IPG ad queue is reordered in accordance with a reordering of the programming ad queue.

parameters” (FF 2). We agree with Appellant that this establishment of a display order means that the ordered list recited in the claims is “specifically not in a random order” (Reply Br. 3). Because we agree with the Examiner that Alexander does not teach any type of order into which its ads are categorized, and we agree with Appellant that something that is “random” cannot fairly be characterized as being in any “order,” we agree with Appellant that the Examiner erred in finding that Alexander teaches an IPG ad queue containing an ordered list of IPG ads.

The Examiner further finds that Alexander teaches reordering of its IPG ad *storage* at column 26, lines 30-56 (Ans. 14). We will assume for the purposes of this section, without deciding, that reordering of IPG ad storage is the same as reordering an IPG ad *queue*. The section of Alexander cited by the Examiner discloses the rotation of Panel Ads in accordance with, for example, an assigned priority. In Alexander, “the ad of the highest priority is displayed the first time a hard page or section is accessed ... the second priority is displayed the next time the user views this page and so forth” (FF 4). *Rotation* is distinct from *reordering*, however, because rotation preserves an initially established order of items, going from the first item in the rotation, to the second, ultimately to the nth and back again to the first. In the context of a queue, only the *pointer* indicating the “head” of the queue is updated, to indicate what item in the *rotation* will be displayed next. In the absence of a specific teaching that the order of rotation of items is changed, then, we will not interpret a rotation through a plurality of items according to an initially determined order to amount to a “reordering.” Accordingly, we find that Alexander does not teach reordering of an IPG ad queue, as recited in claims 28 and 31.

Because Appellant has established error in the Examiner's rejection, we will not sustain the Examiner's rejection of claims 28 and 31, as well as claims 10, 12, 29, 30, 32, 33, 38, and 40-42 not separately argued, under 35 U.S.C. § 103.

CLAIMS 2, 3, 5, 34, 35, AND 37

We reverse *supra* the rejection of claims 28 and 31, from which these claims depend. We have reviewed Hendricks and find that it does not remedy the deficiencies of Alexander and Hite which we have noted. We will therefore reverse the rejection of claims 2, 3, 5, 34, 35, and 37 under § 103 as being unpatentable over Alexander in view of Hite and Hendricks, for the same reasons expressed *supra* with respect to claim 1.

CLAIMS 4 AND 36

We reverse *supra* the rejection of claims 28 and 31, from which claims 4 and 36 depend, respectively. We have reviewed Hendricks and Esch and find that they do not remedy the deficiencies of Alexander and Hite which we have noted. We will therefore reverse the rejection of claims 4 and 36 under § 103 as being unpatentable over Alexander in view of Hite, Hendricks, and Esch, for the same reasons expressed *supra* with respect to claims 1 and 15.

CLAIMS 11 AND 39

We reverse *supra* the rejection of claims 28 and 31, from which claims 11 and 39 depend, respectively. We have reviewed Boylan and find that it does not remedy the deficiencies of Alexander and Hite which we have noted. We will therefore reverse the rejection of claims 11 and 39 under § 103 as being unpatentable over Alexander in view of Hite and

Boylan, for the same reasons expressed supra with respect to claims 28 and 31.

CONCLUSIONS OF LAW

1. Appellant has shown that the Examiner erred in finding that Alexander teaches storing an IPG ad queue containing an ordered list of IPG ads.

2. Appellant has shown that the Examiner erred in finding that Alexander teaches reordering an IPG ad queue in accordance with the displayed programming ad (claim 28) or the reordering of the programming ad queue (claim 31).

ORDER

The Examiner's rejection of claims 2-5, 10-12, and 28-42 is reversed.

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REVERSED

ELD

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